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DEC 09 2004

OFFICE OF PETITIONS

In re Application of :
Van Dijk et al. :
Application No. 09/171,910 : DECISION
International Filing Date: : ON PETITION
April 27, 1995 :
371 Date: March 18, 1999 :
Title of Invention: PLASTIC-BASED :
COMPOSITE PRODUCT AND METHOD AND :
APPARATUS FOR MANUFACTURING SAME :

This is a decision in response to the Petition for Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b), filed November 30, 2004.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. **This time period may not be extended.**

Background:

Applicant filed a Request for Continued Examination (RCE) under 37 CFR 1.114 on July 11, 2002 in the above-identified application, which is the National Stage of an International Application filed on April 27, 1995. The RCE was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. See 37 CFR 1.114(e)(3).

A request for continued examination is not a type of new application filing. See Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092, 50097 (August 16, 2000). The Office cannot convert an improper RCE to an application, such as a continuing application under 37 CFR 1.53(b) or (d). An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. See Manual for Patent Examining Procedure

(MPEP) 706.07(h), page 700-70, subsection III.A., "Treatment of Improper RCE", (8th Ed. 2001).

In the instant case, a final Office action was mailed on March 14, 2002. Under 35 U.S.C. § 133, an applicant has six (6) months to reply to an Office action. Upon failure to prosecute the application within six months of notice of the Office action, the application shall be regarded as abandoned. This statutory requirement may not be waived by the Office. The filing of the improper RCE on July 11, 2002 did not toll the time period set forth in the Office action mailed on March 14, 2002. Thus, the application became **abandoned on September 17, 2002** for the failure to reply to the Office action mailed on March 14, 2002.

The Office, however, mistakenly treated the improper RCE as a proper RCE and reopened the prosecution of the application. A non-final Office action was mailed on October 4, 2002. An Amendment was filed on January 6, 2003. A final Office action was mailed on March 25, 2003. A Notice of Appeal and an Amendment, along with an extension of time were filed on September 26, 2003. An Advisory Action was mailed on October 28, 2003. A second improper RCE was filed on November 24, 2003. A Notice of Allowance and Notice of Allowability were mailed on February 9, 2004 and February 11, 2004 respectively.

Applicant was advised in a Notice Regarding Improper RCE, mailed November 5, 2004, the RCE was improper, and advised to file a petition under 37 CFR 1.137(b) and a terminal disclaimer and fee as set forth in 37 CFR 1.321 because the application was filed before June 8, 1995.

The instant petition

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed); (2) the petition fee required by 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) if required, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). Applicant lacks item (1).

As to item (4), Applicant files the instant petition but has failed to include the terminal disclaimer as required by 37 CFR 1.137(d). Applicant has noted in the petition that this is a utility or plant application filed on or after June 8, 1995, and

as such, a terminal disclaimer is not required. However, the effective filing date of the application is April 27, 1995. Accordingly, a terminal disclaimer and fee as set forth in 37 CFR 1.321 is required.

Any request for reconsideration of petition under 37 CFR 1.137(b) should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: 220 20th Street S.
 Customer Window
 Crystal Plaza Two, Lobby Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this Notice should be directed to the undersigned at (571) 272-3232.



Derek L. Woods
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Office of Petitions